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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Guy Nathan

871-85

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12/08/2009

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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT

PAPER NUMBER

2421

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/621,677	<b>Applicant(s)</b> NATHAN, GUY	
	<b>Examiner</b> DOMINIC D. SALTARELLI	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2009 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 21 and 23 have been considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 21 calls for a song request routine which compares the number of completed and saved questionnaires related to a selected song to a predetermined threshold for deciding when to send a download request for said selected song to a host server.

However, the originally filed specification states [regarding filling out a questionnaire to determine new song titles to request from a host], "Users' choices are memorized in a file stored on the memory means, which is updated whenever a user chooses a new selection in the list. The number of times that a selection is chosen is counted. This number is then compared with a predetermined threshold. When the number of times that a selection is chosen exceeds a predetermined threshold, the reproduction system sends a request to the host server to request that the selection is downloaded."

Contrary to the claim language which states that the number of completed and saved questionnaires relating to a selected song are used to determine whether the predetermined threshold has been exceeded, the specification states that said threshold is based solely on the number of times a particular song is selected within a questionnaire, regardless of whether the questionnaire is even finished.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (5,355,302, of record) [Martin] in view of Wilder (5,408,417, of record), Banks et al. (5,559,714, of record) [Banks], Mauldin (5,748,954), and Alavi (5,970,467, of record).

Regarding claim 21, Martin discloses a jukebox system, connected to a distribution network controlled by a host server (fig. 1) comprising:

a display, operable to display at least a customer interface, wherein the customer interface comprises at least one displayed option, corresponding to at least one song, for selecting the corresponding song to be played (col. 7, lines 18-55);

a memory that stores at least songs that may be played on the jukebox apparatus in response to selections from a customer (col. 5, lines 8-25);

an audio reproduction system providing audio (fig. 1, audio reproduction 127 and speaker 129);

a communication system for enabling the jukebox device to communicate with the distribution network (illustrated in fig. 1, as the jukeboxes and central controller and connected via modems 17 and 19); and

a fee payment device for accepting payment of a fee (col. 5, lines 42-59);

wherein the display is further operable to display at least one option for selecting a song not yet available on the jukebox device for download to the jukebox device (col. 6, lines 3-7 and col. 7, lines 10-17).

Martin fails to disclose the display comprises a touch screen portion and the displayed options are touch selectable, and the display is still further operable to display, said display triggered in response to the purchase, by a user, of predetermined songs, a questionnaire different from touch selectable options for selecting songs for playback and touch selectable options for selecting songs for download, comprising one or more questions for gathering customer information, wherein the touch-screen is operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory, and a song request routine for requesting at least one new song for download from the host server, wherein the at least one song is determined as a function of the answers saved in the questionnaire response file and as a function of number of completed and saved questionnaires, and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed, wherein when the number of completed and saved questionnaires related to the same selected song exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song is downloaded from the host server to the audiovisual reproduction system.

In an analogous art, Wilder teaches an audiovisual reproduction system with a touch screen for user selections (col. 4, lines 13-22), providing an intuitive form of user selections from a very flexible interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin to include a touch screen, as taught by Wilder, for the benefit of providing an intuitive form of user selections from a very flexible user interface.

Martin and Wilder fail to disclose the display is still further operable to display, said display triggered in response to the purchase, by a user, of predetermined songs, a questionnaire different from touch selectable options for selecting songs for playback and touch selectable options for selecting songs for download, comprising one or more questions for gathering customer information, wherein the touch-screen is operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory, and a song request routine for requesting at least one new song for download from the host server, wherein the at least one song is determined as a function of the answers saved in the questionnaire response file and as a function of number of completed and saved questionnaires, and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed, wherein when the number of completed and saved questionnaires related to the same selected song exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song is downloaded from the host server to the audiovisual reproduction system.

In an analogous art, Banks teaches a vending machine system wherein a display is operable to display a questionnaire comprising one or more questions for gathering customer information upon purchase of a predetermined product by the user (the questionnaire is displayed after each purchase), operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory (col. 7, lines 44-65), providing the benefit of valuable customer feedback regarding customer interests and information to interested parties (col. 8, lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin and Wilder to include display of a questionnaire upon purchase of a predetermined product by the user, comprising one or more questions for gathering customer information, operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory, as taught by Banks, providing the benefit of valuable customer feedback to interested parties, such as content distributors and/or marketing firms. The product being purchase is a predetermined song, since the system disclosed by Martin is a musical jukebox with a limited selection of songs.

Martin, Wilder, and Banks fail to disclose a song request routine for requesting at least one new song for download from the host server, wherein the at least one song is determined as a function of the answers saved in the



questionnaire response file and as a function of completed and saved questionnaires, and a reward routine for presenting the customer with a reward is processed, after the determination routine has determined whether the questionnaire was completed, wherein when the number of completed and saved questionnaires related to the same selected song exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song is downloaded from the host server to the audiovisual reproduction system.

In an analogous art, Mauldin discloses downloading files to a local system from remote locations according to a heuristic rule that downloads selections according to popularity, making the most requested files (the predetermined threshold being a function of how many requests are made, since it is the most popular file that is downloaded) locally available for consumption (col. 2, lines 25-51).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Wilder, and Banks according to the disclosure of Mauldin such that when the number of completed and saved questionnaires related to the same selected song exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song is downloaded from the host server to the audiovisual reproduction system.

Martin, Wilder, and Banks fail to disclose a reward routine for presenting the customer with a reward is processed, after the determination routine has determined whether the questionnaire was completed.

In an analogous art, Alavi teaches a method for accurately collecting market research survey data by involves providing a reward to users upon completion of a survey (col. 1 line 50 - col. 2 line 24).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Wilder, Banks, and Mauldin to and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed, as taught by Alavi, for the benefit of providing incentive to users to fully complete presented surveys.

Regarding claim 23, Martin, Wilder, Banks, Mauldin, and Alavi disclose the system of claim 21, wherein the reward routine provides the customer a free song selection for completing the questionnaire (Alavi teaches providing free, limited use of the system in return for completing a survey, and according to Martin, the system is a song playing jukebox, thus free limited use of a jukebox is access to a free song selection).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/  
Primary Examiner, Art Unit 2421